

O-466-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2605692
BY ANIL SETHI
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 30 & 43:**

BFL BIKANER

AND

**OPPOSITION THERETO (NO 103309) BY BIKANERVALA FOODS PRIVATE
LIMITED**

The background and the pleadings

1) Anil Sethi applied for the trade mark **BFL BIKANER** on 29 December 2011. It was published in the Trade Marks Journal on 10 February 2012. Registration is sought for the following goods and services:

Class 30: Indian savouries & sweets made of rice, corn & flour Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services

2) Bikanervala Foods Private Limited (“BFP”) opposes the registration of the mark. A number of grounds are relied upon, one of which is under section 3(6) of the Trade Marks Act 1994 (“the Act”) based on the claim that Mr Sethi was previously BFP’s distributor in the UK and that applying for a similar mark after his distribution agreement was canceled constitutes an act of bad faith. These claimed facts also give rise to a claim under section 60 of the Act. Claims under various relative grounds of opposition are also made, as set out below:

- i) Claims under sections 5(2)(b) and 5(3) of the Act on the basis of UK trade mark 2410645 for the word: **BIKANERVALA** in respect of “restaurant services” in Class 43. The mark was filed on 10 January 2006 and it completed its registration procedure on 4 August 2006. The registration procedure was completed more than five years before the date on which Mr Sethi’s application was published, therefore, the mark is subject to the proof of use requirements set out in section 6A of the Act. A statement of use was made by BFP for proof of use purposes, a statement that the mark had been used for the services as registered.
- ii) Claims under sections 5(2)(b) and 5(3) of the Act on the basis of UK trade mark 2410643 for the word: **BIKANO** in respect of “snacks made from cereal, wheat and corn, traditional Indian deserts made from milk and cereals, candied fruit, crackers, cakes, candied bar” in class 30. The mark was filed on 10 January 2006 and it completed its registration procedure on 11 August 2006. This mark is also subject to the proof of use requirements set out in section 6A of the Act. A statement of use was made by BFP for proof of use purposes, a statement that the mark had been used for the goods as registered.

iii) A claim is made under section 56 of the Act in that BFP own marks (BIKANO and BIKANERVALA) which are well-known in various countries world-wide.

3) Mr Sethi filed a counterstatement denying the claims. The thrust of his defence is that his mark does not copy those of BFP and that the word BIKANER is only present in his mark as a reference to the city of Bikaner (in the Indian state of Rajasthan) which he considers to be famous for certain Indian foodstuffs. He states that he has worked hard and spent a lot of money to make his mark famous in the UK with no intention to take unfair advantage of BFP's marks. Mr Sethi did not put BFP to proof of use in respect of its earlier marks (he left the relevant part of the Form TM8 blank). The consequence of this is that the earlier marks can be relied upon for the goods/services for which they are registered, the statement of use not having been put into issue.

4) Both sides filed evidence. Neither side requested a hearing or submitted written submissions in lieu of a hearing.

BFP's evidence

5) The evidence is given by Ravindra Kumar, a solicitor at the firm Singhanian & Co Solicitors. Mr Kumar states that his evidence come from the records maintained by BFP and that he is authorized to speak and give evidence on its behalf.

6) Mr Kumar states that Mr Sethi's mark was filed in bad faith because BFP is the trade mark owner of a mark similar to Mr Sethi's mark; he specifically refers to BFP's BIKANERVALA trade mark. It is further stated that Mr Sethi was the sole distributor of BFP's products in the UK for "a long time" and that he is fully aware of BFP's registered trade mark. Mr Kumar refers to Exhibit RK1 which includes trade mark registration certificates (or other material supporting registration) from around the world, including the UK, Oman, New Zealand, Canada, Qatar, the US and Australia; the marks in question are BIKANERVALA and BIKANO. Further statements are made that the application was made in bad faith because of the similarity between the respective marks. Further material in Exhibit RK1 constitute printouts from what appears to be Mr Sethi's website and which is headed with a BFL BIKANER mark (in logo form); also depicted is BFP's mark (BIKANO) - a scan of one of the pages can be seen below:



Mr Sethi's evidence

7) The evidence comes, in the form of a witness statement, from Mr Sethi himself. He begins his evidence by stating that in BFL BIKANER, BFL stands for BINAKER FOODS LONDON and BIKANER represents the Indian city of Bikaner which is, he states, famous for its savouries, snacks and sweets. Later in his evidence he repeats this information (concerning the city of Bikaner) and adds that:

“Thousands of businesses around the world associate Bikaner name to their business to let the customers know about the taste and range of products they do. So that, when customer buy products they expect the taste of the product Bikaner city is famous for.”

Mr Sethi draws an analogy with the use of London in, for example, Rimmel London. Also provided is a print from an Indian Government website about Bikaner which states at the bottom of the page “The Town is also famous for delicacies like Rasgullas, Bhujias and Papads”.

8) Mr Sethi states that he has developed the brand's own identity in good faith and has invested thousands of pounds developing its reputation. He states, in any case, that the “logo of the brand” is not similar or identical. He attaches pictures of the actual forms of use (in logo form – BLF BIKANER and BIKANO can be seen above), however, this is not really pertinent given that the respective trade marks before the tribunal are plain word marks.

9) Mr Sethi states that BFP is a private labeling supplier to different companies. He states that he approached BFP to carry out the private labeling for BFL BIKANER but later BFP wanted to supply its own brand BIKANO to Mr Sethi, thus BFP had been supplying Mr Sethi under BFL BIKANER before it supplied its own brand to him. He states that he has no intention of selling his goods in bad faith.

BFP's claim that its marks have a reputation

10) BFP's grounds of opposition include section 5(3) of the Act, a prerequisite of which is that the marks relied upon have a reputation, and, under section 56(1) of the Act, on the basis that its earlier marks constitute well-known marks (it seeks to rely upon its claims to well-known mark status under sections 5(2)/5(3) of the Act). With regard to a reputation under section 5(3), I note what the Court of Justice of the European Union ("CJEU") stated in *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 with regard to the degree of knowledge necessary for a mark to have a reputation:

"The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark."

11) Other than its basic claims, together with statements about Mr Sethi being a distributor of BFP's goods, all that has been provided in evidence are trade mark registration details from a number of countries around the world. This does not even demonstrate actual use let alone use which will have established a reputation. The evidence filed is wholly inadequate. It has not been established that the earlier marks have a reputation. **The claims under section 5(3) can, therefore, be dismissed. Similarly, the claim that the earlier marks constitute well-known marks under section 56(1) of the Act is also dismissed for the same reasons.**

12) Under section 5(2) of the Act, the greater the distinctiveness of the earlier marks, the greater the likelihood of confusion. Distinctiveness can come from both the inherent qualities of the earlier marks and/or from the use made of them. Given my findings above, when I come to assess the distinctiveness of the earlier marks, I need only consider their inherent qualities

Section 5(2)(b) – the legislation and the leading case-law

13) Section 5(2)(b) of the Act reads:

"5.-(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

14) The CJEU has issued a number of judgmentsⁱ which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

15) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can vary, depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). Both parties have goods in class 30 as follows:

Applied for mark: Indian savouries & sweets made of rice, corn & flour
Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Earlier mark: Snacks made from cereal, wheat and corn, traditional Indian deserts made from milk and cereals, candied fruit, crackers, cakes, candied bar.

16) The above are food products and some products for making drinks. The average consumer is a member of the general public in the UK. The fact that some of the goods are identified as being Indian (savouries and sweets) does not affect the identification of the average consumer. Indian food (including the type of food in the specifications) is consumed not just by people of Indian descent, but by people with various ethnic backgrounds. The goods will most often be self selected so the visual aspects of the marks take on more importance, however, aural similarity still has a role to play as the goods could still be requested orally. Given that the goods are generally low cost, frequently purchased items, the degree of care and consideration used in the selection process will, at best, be of an average level; for some of the goods (e.g. staple products or very low cost items) the degree of care and attention will be lower than average.

17) Both parties have services in class 43 as follows:

Applied for mark: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services

Earlier mark: Restaurant services

18) For the services which relate to food and drink, the average consumer is, again, a member of the general public in the UK. The services are used fairly frequently. The cost of the service will vary depending on the establishment chosen. Generally speaking, a reasonable degree of care and consideration will be used when selecting a service provider. The selection process will predominately be by the eye, although aural similarity will not be ignored from my assessment.

19) For the services relating to temporary accommodation and holiday accommodation then, again, the average consumer will most often be a member of the general public. Although, business users may also come into play with regard to temporary accommodation. Generally speaking, a reasonable degree of care and consideration will be used when selecting a service provider. The selection process will predominately be by the eye, although aural similarity will not be ignored from my assessment.

20) In relation to crèche services, the average consumer will be a member of the general public with parental or guardianship duties. Who to leave your child with is an important choice so the degree of care and consideration is likely to be higher than the norm. The selection process will predominately be by the eye, although aural similarity will not be ignored from my assessment. In relation to retirement home services, the average consumer will be a retired person or family members with responsibility for an elderly relative; the degree of care and attention used in the selection of a service provider will be high.

The distinctiveness of the earlier marks

21) As stated earlier, it is only the inherent qualities of the earlier marks that I need to consider. The earlier marks are: **BIKANERVALA** (for the class 43 services) and **BIKANO** (for the class 30 goods). Mr Sethi has referred in his evidence to the city of Bikaner in India. If the average consumer saw either of the earlier marks as making some form of nod towards the city of Bikaner, this could impact upon the marks' distinctive character (although the marks must be assumed to have some distinctive character). In my view, no such nod will be seen. The reason for this is that whilst the city of Bikaner is no doubt a real place (Mr Sethi has provided evidence to this effect) and whilst it may be known in some quarters as a city famous for certain foods, this does not mean that the average UK consumer will have heard of Bikaner. The evidence provided does not establish that the city is known to any meaningful extent, not even by those of Indian descent, let alone the average consumer in the UK. The consequence of this finding is that, from the perspective of the average consumer, and measured against the goods/services for which the marks are registered, the marks possess no descriptive or allusive characteristics. The marks are not known

words. The marks will be seen, to all intents and purposes, as invented words. **The marks must, therefore, be viewed as highly distinctive trade marks.**

Comparison of the goods/services

22) When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

23) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

24) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the

responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

25) In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying to rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

26) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

27) I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

28) I will go through the applied for specification term by term, but grouping the terms where it is reasonable to do so. The terms need to be compared with the following in the earlier marks:

Class 30: Snacks made from cereal, wheat and corn, traditional Indian deserts made from milk and cereals, candied fruit, crackers, cakes, candied bar

Class 43: Restaurant services

Indian savouries made of rice, corn & flour

29) Such products clearly clash with "snacks made from cereal, wheat and corn" which could, in fact, be Indian savouries themselves. **The goods are either identical or, at the very least, highly similar.**

30) Insofar as class 43 of the earlier mark is concerned, this covers restaurant services. The purpose, method of use and nature differs from the applied for goods. There is no competition or complementarity (in the sense described by the case-law). It is not common for restaurants to sell or market house/own brand savouries or sweets. **The goods are not similar to the service.**

Coffee, tea, artificial coffee

31) There is no clear counterpart in the class 30 specification of the earlier mark. The terms in the earlier mark cover distinct food items with no real link to tea or coffee. The purpose, nature and trade channels (at least in terms of where the goods will be displayed in a supermarket) differ. The goods do not compete nor are they complementary. **The goods are not similar.**

32) In terms of restaurant services, the purpose, method of use and nature differs from the applied for goods. There is no competition or complementarity (in the sense described by the case-law). It is not common for restaurants to sell or

market house/own brand tea or coffee. **The goods are not similar to the service.**

Cocoa

33) Cocoa can be used to make a drink (such as hot chocolate) and from that perspective does not create any similarity with the earlier marks' goods or services as per my assessment in relation to tea and coffee. Cocoa can also be used as an ingredient in items such as cakes or to dust the top of items to give sweetness. However, such uses do not, again, create any meaningful degree of similarity of purpose to the goods (or services) of the earlier mark, there is no similarity in nature or channels of trade and there is no obvious aspect of competition or complementarity. **Cocoa is not similar to the goods or services of the earlier marks.**

Rice, tapioca, sago,

34) Such goods cover the raw basic product (e.g. rice itself) rather than the product into which they can be made (e.g. rice pudding). Nevertheless, they can be purchased with the aim of making them into some form of pudding or dessert and, therefore, have a degree of similarity to "traditional Indian deserts made from milk and cereals" on account of this similar purpose. The goods could be purchased as an alternative to a finished dessert. The goods could be located close to each other (although perhaps not next to each other). **I consider the goods to be reasonably similar.**

35) In terms of restaurant services, the purpose, method of use and nature differ from the applied for goods. There is no competition or complementarity (in the sense described by the case-law). It is not common for restaurants to sell or market house/own brand versions of these goods. **The goods are not similar to the service.**

Preparations made from cereals

36) Such goods would include the goods of the earlier mark and **are thus identical**. Even where the goods are not identical **then they are still reasonably similar** (to the snacks of the earlier mark) on account of their nature and purpose etc.

37) In terms of restaurant services, the purpose, method of use and nature differs from the applied for goods. There is no competition or complementarity (in the sense described by the case-law). It is not common for restaurants to sell or market house/own brand versions of these goods. **The goods are not similar to the service.**

Bread

38) The fact that bread can be eaten does not give the goods a sufficient degree of similarity with the goods of the earlier mark. The nature is quite different, there is no real overlap in trade channels (beyond them both being sold in supermarkets) and there is no aspect of competition or complementarity. There is no greater prospect of similarity against restaurant services. **Bread is not similar to the goods or services of the earlier marks.**

Pastry

39) I come to the same conclusion with regard to pastry as I do for bread, for similar reasons. **Pastry is not similar to the goods or services of the earlier marks.**

Confectionery; Indian sweets made of rice, corn & flour

40) The earlier mark covers a variety of items that could be classed as confectionery. **As such, identical goods are considered to be in play.** Even if a revision to the applied for term was made to exclude identical goods, then, as the items are all confections, **there would still be similarity of a reasonable degree.**

41) In terms of restaurant services, the purpose, method of use and nature differs from the applied for goods. There is no competition or complementarity (in the sense described by the case-law). It is not common for restaurants to sell or market house/own brand versions of these goods. **The goods are not similar to the service.**

Ices

42) Ices are a form of confection and, also, could be eaten as a dessert. Although the exact nature differs from the desserts and confections covered by the earlier mark, there is still a similarity of purpose. The goods could also be purchased as an alternative to the goods of the earlier mark. **I consider there to be a reasonable degree of similarity.**

43) In terms of restaurant services, the purpose, method of use and nature differs from the applied for goods. There is no competition or complementarity (in the sense described by the case-law). It is not common for restaurants to sell or market house/own brand versions of these goods. **The goods are not similar to the service.**

Ice

44) Although ices could be classed as a confection or dessert, ice per se would not. Ice is a simple product, frozen water, likely to be sold in cube form. The goods are, thus, quite different and there is even less prospect of similarity against restaurant services. **Ice is not similar to the goods or services of the earlier marks.**

Baking-powder; salt, mustard; vinegar, sauces (condiments); spices; yeast, flour, sugar, honey, treacle

45) The above are all basic food ingredients. However, the simple fact that the goods can be used as basic ingredients in something (even in the goods of the earlier mark) does not necessarily equate to similar goods. Something more is required than that. Obviously, the nature of the goods is different as are the methods of use. One would not buy the goods as an alternative to the goods of the earlier mark. **The goods are not similar. There is no greater prospect of similarity against restaurant services.**

Sandwiches

46) Sandwiches are often purchased as something which is quick and easy to eat as a snack. They, thus, serve a similar purpose to the snacks of the earlier mark. They could be sold in fairly close proximity (although not next to each other) and there is an element of competition. The nature is, though, likely to be very different. **I conclude that there is a low degree of similarity between the goods.**

47) In terms of restaurant services, the purpose, method of use and nature differs from the applied for goods. There is no competition or complementarity (in the sense described by the case-law). It is not common for restaurants to sell or market house/own brand versions of these goods. **The goods are not similar to the service.**

Pies

48) I consider the assessment here to be similar to that for sandwiches. Pies can also be purchased as a component of a meal, but this gives rise to no greater degree of similarity to the goods of the earlier mark. **There is a low degree of similarity between pies and the class 30 goods of the earlier mark, but no similarity to restaurant services.**

Prepared meals, pizzas, and pasta dishes.

49) Unlike pies or sandwiches, the above goods are complete, or virtually complete, meals. The closest goods in class 30 of the earlier mark are “snacks

made from cereal, wheat and corn”. However, the nature of the goods differs, and beyond the fact that all the goods can be eaten, there is little similarity in purpose or method of use (in terms of preparation etc). The goods will not be located in close proximity. The goods do not strike me as truly competitive or complementary. **The goods are not similar to the class 30 goods of the earlier mark.**

50) In terms of restaurant services, such services would include pizzerias and, also, takeaway restaurant pizza services. From this perspective there is a clear competitive relationship. The average consumer may choose to either purchase a pizza from a shop and cook it at home, or, alternatively, to go out for pizza or obtain it ready cooked from a pizza takeaway service. There is of course an inherent difference between the nature of a good and the nature of a service (which also impacts on the method of use) but the purpose is the same in terms of both the good and the service relating to the consumption of pizza. I consider pizza to be reasonably similar to restaurant services. Similar analysis can be applied to the other goods applied for and the relationship with certain types of restaurant. For example, pasta dishes and Italian restaurants. There is also greater likelihood that restaurants may sell or market house/own brand versions of these goods. **In short, I consider the above goods to be similar to restaurant services, but only to a moderate level.**

Services for providing food; restaurant and catering services

51) The applied for restaurant service is **obviously identical to the restaurant service covered by the earlier mark.** Furthermore, the applied for term “services for providing food” includes restaurant services within its ambit and is, **therefore, also considered identical.** In relation to this second term, even for services that fall within its ambit which are not classed as restaurants (such as cafes, takeaways etc) there is still a similarity of purpose and method of use, together with a key aspect of competition. In reality, there is a very fine line between different types of services for providing food. Similar observations apply to catering services which include catering provided to the public at events. **The services are, at the very least, highly similar.**

Services for providing drink; bar services

52) Food and drink go hand in hand. Restaurants will have bars and bars will very often provide food, so there is similarity in terms of trade channels and purpose. A consumer may choose between going to a bar for food or going to a restaurant, so there is a competitive relationship. The visiting of premises to sit down to eat or drink creates a similarity in the methods of use. **The services are highly similar.**

Booking and reservation services for restaurants

53) Simply phoning a restaurant to book a table does not constitute a booking/reservation service. Such a service is likely, instead, to be provided by a third party to a restaurant, with the consumer then phoning the service provider to make a booking which will be taken on the restaurant's behalf. The consumer will, nevertheless, see some similarity in purpose as the services are being used with the end result of dining in a restaurant. The methods of use differ. There is no competition but a degree of complementarity. **There is a reasonable degree of similarity.**

Temporary accommodation; provision of holiday accommodation

54) Such services will include hotel services within their ambit. A hotel service has a key function of providing rooms for overnight stays (or longer) (and other facilities), but they also have other key functions including the provision of food and drink in a hotel restaurant. Restaurants often form a very important aspect of a hotel. Some consumers will choose to go to a restaurant in a hotel as opposed to a standalone restaurant even if they are not resident in the hotel. This creates a similarity in purpose, method of use, and in the channels of trade. **The services are reasonably similar.** I must bear in mind that the above terms cover other temporary accommodation/holiday accommodation services which are not hotels and which may not be similar to BFP's services in class 43. For example, the provision of self catering holiday apartments would not be similar. If it becomes necessary, I will consider later in this decision whether I need to request submissions from the parties on possible revised specifications.

Booking and reservation services for holiday accommodation

55) Approached on the same basis as above, these services are more distant as the user is likely to be booking the accommodation aspect rather than a restaurant in the accommodation. **The services are not similar to restaurant services.**

Retirement home services

56) The purpose and method of use of a retirement home is very different from the purpose of the restaurant service of the earlier mark. There is no competitive or complementary relationship. Although food is consumed in a retirement home, this does not create any meaningful similarity with a restaurant. As far as I am aware, retirement homes would not ordinarily incorporate a restaurant (there is no evidence to suggest the contrary), it is simply that the residents are fed; consequently there is no overlap in trade channels. **The services are not similar.**

Creche services

57) The purpose and method of use of a crèche is very different from the purpose of the services of the earlier mark. There is no competitive or complementary relationship. There is no evidence as to whether there is an overlap in trade channels, there is no obvious overlap of which I am aware. **The services are not similar.**

58) In making the comparison of the applied for services, I have focused on the potential clash with the services in class 43 of the earlier mark. For the sake of completeness, I have also borne in mind the goods in class 30 of the earlier mark but this does not put BFP in any stronger position and, indeed, would, as far as I can see, **result in a finding of no similarity.**

Summary of goods/services comparison

59) I have found the following goods and services to have no similarity with the goods/services of the earlier marks:

Class 30: Coffee, tea, cocoa, sugar, artificial coffee; flour, bread, pastry; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 43: Booking and reservation services for holiday accommodation; retirement home services; creche services.

60) Similarity between the goods/services is a prerequisite under section 5(2)(b) of the Act. **Consequently, the ground of opposition fails in respect of the above goods and services and will not be returned to under section 5(2)(b) of the Act.** The following goods/services were found to be either identical or similar and will therefore form part of the subsequent assessment:

Class 30: Indian savouries & sweets made of rice, corn & flour; rice, tapioca, sago; preparations made from cereals, confectionery, ices; prepared meals; sandwiches; pizzas, pies and pasta dishes.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants.

Comparison of the marks

61) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall

impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

Mr Sethi's mark	BFP's marks
BFL BIKANER	BIKANERVALA BIKANO

62) In Mr Sethi's mark there are two distinct elements, BFL and BIKANER. Given my earlier comments regarding the average consumer's likely knowledge of the city of Bikaner, that element must be regarded as an independent and distinctive part of the mark. The letters BFL are also an independent and distinctive part of the mark. In my view, both elements play a roughly equal role in the mark. BFP's marks do not really break down into components and will be seen as single, albeit invented, words.

63) With regard to the comparison with BIKANERVALA, there is a degree of visual and aural similarity on account of the common presence of BIKANER in both marks. However, both marks have additional aspects (BFL in Mr Sethi's mark at its beginning, and VALA in BFP's mark at its end). This creates an important difference which reduces the similarity. On balance, I consider there to be some visual and aural similarity, but of only a moderate degree. As neither mark has any concept, the conceptual comparison is neutral.

64) With regard to the comparison with BIKANO, the position is somewhat different. Both marks have an element which begins with the letters BIKAN-, but Mr Sethi's mark has the additional letters BFL at the beginning. Further, the elements beginning BIKAN- have different endings –ER/-O, although this impacts more on the eye than the ear. I consider there to be a moderate degree of visual similarity, with a reasonable (but certainly not high) degree of aural similarity. As neither mark has any concept, the conceptual comparison is neutral.

Likelihood of confusion

65) The factors assessed so far have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

66) The earlier marks have a high degree of inherent distinctive character. However, the degree of similarity between the marks is of only a moderate level. Imperfect recollection must be borne in mind together with the fact that the selection process is not highly considered (although it is, in the main, an averagely considered one). I consider imperfect recollection to be particularly

important in this case due to the lack of conceptual significance in the respective marks – without a conceptual hook to assist the average consumer with recall, the effects of imperfect recollection may be heightened. The interdependency between the factors is important. I will therefore go through the goods and services separately (but grouping them together when it is useful to do so).

Indian savouries made of rice, corn & flour

67) I found no similarity with BFP's earlier mark in class 43. However, I found the goods to be either identical or, at the very least, highly similar to the goods in class 30 of the earlier mark (BIKANO). When the concept of imperfect recollection is borne in mind, I consider there is a likelihood of BIKANER (in the applied for mark) being imperfectly recalled as BIKANO, a highly unusual word with no concept (or vice versa). I must though consider the marks as a whole and must bear in mind that the applied for mark is BFL BIKANER. However, I still consider that there is a likelihood of imperfect recollection regardless of the additional element BFL; even if an average consumer recalled the addition of BFL, this is likely to be put down to BFL being a house mark and BIKANER a sub-mark, so the similarity between the marks may still be put down to the goods coming from the same or a related undertaking. **Either way, there is a likelihood of confusion.** In reaching this finding I have not mentioned Mr Sethi's point about Bikaner being an Indian city known for food products. This is because, as I have already stated, the average consumer cannot be deemed to know of this and, therefore, it has no operative effect on the assessment of whether there is a likelihood of confusion.

Rice, tapioca, sago,

68) I found no similarity with BFP's earlier mark in class 43. However, I found the goods to be reasonably similar to the class 30 goods. The same earlier mark as above is in play. The same rationale applies here. Although the goods are only reasonably similar (as opposed to identical or highly similar), I consider the relationship between the goods (as assessed) is one which, when all the factors are borne in mind, **will still lead to a likelihood of confusion.**

Preparations made from cereals

69) I found no similarity with BFP's 43 earlier mark in class 43. However, I found the goods to be identical to the goods in class 30 of the earlier mark. The same earlier mark as above is in play. The same rationale applies here. The goods are also identical. **There is a likelihood of confusion.**

Confectionery; Indian sweets made of rice, corn & flour

70) I found no similarity with BFP's earlier mark in class 43. However, I found the goods to be identical to the goods of the earlier mark. The same earlier mark as

above is in play. **There is a likelihood of confusion.** Even if a revision to the applied for term was made to exclude identical goods, then, as the items are all confections, there would still be similarity of a reasonable degree and consistent with the findings already made, **there is still a likelihood of confusion.**

Ices

71) I found no similarity with BFP's earlier mark in class 43. However, I found the goods to be reasonably similar to the goods of the earlier mark. The same rationale applies here. Even though the goods are just reasonably similar, **there is a likelihood of confusion**

Pies and sandwiches

72) I found no similarity with BFP's earlier mark in class 43. However, I found the goods to be similar to the class 30 goods, although only to a low level. The same earlier mark as above is in play. In this case, the combination of the low level of similarity in the goods and the moderate level of similarity in the marks, even bearing in mind the concept of imperfect recollection, is not sufficient for there to be a likelihood of confusion. The relationship between the goods is not sufficiently close to cause confusion with regard to the degree of similarity in the marks. **There is no likelihood of confusion.**

Services for providing food; restaurant and catering services

73) I found no similarity with BFP's earlier mark in class 30. However, I found the services to be identical or highly similar to the services of the earlier mark BIKANERVALA. The earlier mark differs from the assessments already made. The marks are, though, still moderately similar. Whilst -VALA is present in the earlier mark, the common aspect is even closer as both contain BIKANER-, a highly distinctive combination of letters. Bearing in mind imperfect recollection, I **consider that there is a likelihood of confusion**, although this is more likely to arise from the average consumer considering that the services come from the same or an economically linked undertaking.

Services for providing drink; bar services

74) I found no similarity with BFP's earlier mark in class 30. However, I found the services to be highly similar to the services of the earlier mark BIKANERVALA. A similar analysis can be made as above and the link between the services is sufficiently close that **there is a likelihood of confusion.**

Booking and reservation services for restaurants

75) I found no similarity with BFP's earlier mark in class 30. However, I found the services to be reasonably similar to the services of the earlier mark

BIKANERVALA. A similar analysis can be made as above and the link between the services is sufficiently close that **there is a likelihood of confusion.**

Temporary accommodation; provision of holiday accommodation;

76) I found no similarity with BFP's earlier mark in class 30. However, I found the services to be reasonably similar to the services of the earlier mark BIKANERVALA. A similar analysis can be made as above and the link between the services (to the extent that the applied for services cover hotels) is sufficiently close that **there is a likelihood of confusion.**

Prepared meals, pizzas, and pasta dishes.

77) I found no similarity with BFP's earlier mark in class 30. However, I found the goods to be moderately similar to the services of the earlier mark BIKANERVALA. In this case, the combination of the moderate level of similarity in the goods/services and the moderate level of similarity in the marks, even bearing in mind the concept of imperfect recollection, is not sufficient for there to be a likelihood of confusion. The relationship between the goods/services is not sufficiently close to cause confusion with regard to the degree of similarity in the marks. **There is no likelihood of confusion.**

Summary of conclusions under section 5(2)(b)

78) The opposition under section 5(2)(b) fails in respect of:

Class 30: Coffee, tea, cocoa, sugar, artificial coffee; flour, bread, pastry; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 43: Booking and reservation services for Holiday accommodation; retirement home services; creche services

79) But succeeds in respect of:

Class 30: Indian savouries & sweets made of rice, corn & flour; rice, tapioca, sago; preparations made from cereals, confectionery, ices.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants.

Section 3(6) of the Act

Legislation and the leading case-law

80) Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

81) In *Red Bull GmbH v Sun Mark Ltd & Anr* [2012] EWHC 1929 and [2012] EWHC 2046 (Ch) (“*Sun Mark*”) Arnold J summarised the general principles underpinning section 3(6) as follows:

“Bad faith: general principles

130 A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/ Article 3(2)(d) of the Directive/ Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131 First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132 Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2009] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133 Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207–2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134 Fourthly, bad faith includes not only dishonesty, but also “some dealings which fall short of the standards of acceptable commercial

behaviour observed by reasonable and experienced men in the particular area being examined”: see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135 Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136 Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137 Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138 Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

“41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as

a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089 , paragraph 48).”

The relevant date

82) Whether the trade mark was applied for in bad faith must be assessed at a particular point in time. Evidence from after the relevant date can, however, be instructive in deciding whether the application was made in bad faith at the relevant date if it sheds light backwards. As stated in the *Sun Mark* case, the relevant date is the application date of the trade mark. The relevant date is 29 December 2011.

Decision in relation to bad faith

83) The pleaded case is based on the act of filing a similar mark to BFP in circumstances when Mr Sethi would have known of BFP’s marks on account of him previously being a distributor of BFP. To that extent, there seems little point in probing the matter in detail given that I have already made findings under section 5(2)(b) of the Act in BFP’s favour (albeit partially). For those goods/services that were not refused under section 5(2)(b) why should there be any problem in Mr Sethi’s applying for them if the combination of the mark and the goods/services does not result in confusion? There is certainly nothing in the pleaded case or BFP’s evidence to provide an explanation. Furthermore, Mr Sethi has provided evidence that the origins of his mark come from the city of Bikaner – this evidence is not challenged. Although this does not impact on the likelihood of confusion (for the reasons already explained), it does go to Mr Sethi’s motivation for filing the mark. Mr Sethi has also stated in evidence that his mark was labelled by BFP before it even coined its own BIKANO mark. This is further support for Mr Sethi. On the basis of the pleadings and evidence before the tribunal, **it is not established that Mr Sethi acted in bad faith by filing the application.**

Section 60(1)

84) This reads:

“60. - (1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2) If the proprietor opposes the application, registration shall be refused.”

85) It seems to me that BFP’s opposition under this ground is misconceived. Mr Sethi has not applied for BFP’s trade marks. Whether he has applied for a similar mark sufficient to cause confusion (or some other form of damage) is a different matter and has already been assessed. **The ground of opposition is dismissed.**

Outcome of opposition

86) The goods/services identified under paragraphs 78 and 79 are those which are to be registered/refused respectively.

Costs

87) The net effect of the opposition strikes me as something of a score-draw. In the circumstances, I do not propose to favour either party with an award of costs.

Revised specification

88) In my conclusions, I have upheld the opposition against “temporary accommodation; provision of holiday accommodation” on the basis that such terms include, for example, hotel services. However, if the terms were to be limited then it may be possible to register the mark for other forms of temporary accommodation/holiday accommodation. I gave an example of the provision of self-catering holiday apartments earlier in this decision. In view of this, Mr Sethi is permitted 14 days to put forward any revised terms that:

- i) Fall within the ambit of “temporary accommodation; provision of holiday accommodation” in class 43;
- ii) And do not have restaurants/other food and/or drink related services as a key component.

89) Mr Sethi should copy any revised terms he suggests to BFP who will be allowed 14 days to comment. I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If Mr Sethi puts

forward no revised terms then I will issue a supplementary decision confirming the outcome as it stands in paragraphs 78 & 79 above. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision.

Dated this 21st day of November 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).